

**REMARKS**

In a restriction requirement dated August 8, 2007, the Examiner required restriction under 35 U.S.C. §§ 121 and 372 between:

Group I, claim(s) 39-58, drawn to a method.

Group II, claim(s) 59-76, drawn to a fuel emulsion compound.

See Aug. 8, 2007, Office Action at 2.

Applicants respectfully traverse the restriction requirement. However, to be fully responsive, Applicants elect, with traverse, the subject matter of Group I, comprising claims 39-58 drawn to a method for reducing emission of pollutants from an internal combustion engine.

The Examiner admits that “[i]nventions I and II are related as product and process of use.” *Id.* at 2. However, the Examiner argues that the inventions are distinct because “the method could be used to reduce exhaust emissions.” *Id.* Applicants respectfully disagree and traverse the restriction requirement on the grounds that the Examiner has not met her burden to justify a restriction requirement, and, thus, there are several errors in the Restriction Requirement.

First, Applicant respectfully refers the Examiner to M.P.E.P. § 803, which sets forth the criteria and guidelines for Examiners to follow in making proper requirements for restriction. The M.P.E.P instructs the Examiner as follows:

If the search and examination of all the claims in an application can be made **without serious burden**, the examiner **must** examine them on the merits, even though they include claims to independent or distinct inventions.

M.P.E.P. § 803 (emphasis added).

Here, the Examiner has not shown that examining Groups I and II together would constitute a serious burden. Rather, the Examiner admits that Groups I and II are related as: product and process of use. The Examiner contends that related Groups I and II can also be distinct, but does not specify what serious burden will be placed on the Examiner if she were to proceed in examining the groups together, as required by M.P.E.P. § 803.

Second, unity of invention differs from restriction practice and is expressly understood to permit applicants to prosecute both products claims and methods of use of product claims together. M.P.E.P. § 1850(III)(A)(A) states that “[t]he method for determining unity of invention under PCT Rule 13 shall be construed as **permitting**, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application: . . . In addition to an independent claim for a given **product**, . . . and an independent claim for a **use** of the said product. . . .” (Emphasis added); see *also* 37 C.F.R. § 1.475(b)(2).

Third, the fact that unity of invention permits applicants to prosecute both apparatus and process claims together is further supported by the determinations of the International Preliminary Examining Authority. Both in the June 7, 2004, International Preliminary Examination Report and in the February 10, 2004, Written Opinion, the IPEA conclusively determined that the pending claims possessed unity of invention.

Accordingly, Applicants submit that the Examiner’s restriction requirement is improper and should be withdrawn in view of (1) failure to establish a burden, (2) misapplication of PCT Rule 13, and (3) repeated and contrary determinations of the IPEA.


Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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By: \_\_\_\_\_

  
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